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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/814,536	03/30/2004	Jonathan J. Hull	20412-08421	6884
758	7590	11/29/2005	EXAMINER	
FENWICK & WEST LLP SILICON VALLEY CENTER 801 CALIFORNIA STREET MOUNTAIN VIEW, CA 94041			SINGH, SATWANT K	
			ART UNIT	PAPER NUMBER
			2626	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/814,536 ✓

Applicant(s)

HULL ET AL.

Examiner

Satwant K. Singh

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 March 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-40 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 March 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 3/30/04, 10/31/05, 10/27/04
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Priority

1. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or under 35 U.S.C. 120, 121, or 365(c) is acknowledged. Applicant has not complied with one or more conditions for receiving the benefit of an earlier filing date under 35 U.S.C. [1] as follows:

The later-filed application must be an application for a patent for an invention which is also disclosed in the prior application (the parent or original nonprovisional application or provisional application). The disclosure of the invention in the parent application and in the later-filed application must be sufficient to comply with the requirements of the first paragraph of 35 U.S.C. 112. See *Transco Products, Inc. v. Performance Contracting, Inc.*, 38 F.3d 551, 32 USPQ2d 1077 (Fed. Cir. 1994).

The disclosure of the prior-filed application, Application No. 09/728,453 and 09/728,560, fails to provide adequate support or enablement in the manner provided by the first paragraph of 35 U.S.C. 112 for one or more claims of this application. Claims 1-40 are geared towards a printing device and the methods of transmitting data to the printing device. Prior filed applications 09/728,453 and 09/728,560 are geared toward the communication of multi-media data. The printing device and the method of transmitting the print data to the device are not in the prior filed applications.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-7, 9, 10, 12, 13, 17-19, 23-28, 30, 32, 34-36, and 40 are rejected under 35 U.S.C. 102(e) as being anticipated by Parry (US 2002/0131071).

4. Regarding Claim 1, Parry discloses a method, comprising: receiving, by a printer, a document having a pointer (barcode) pointing to data that is not in the received document (Fig. 2, S110) (data is applied on line to the input/output circuitry 50 of the device 10) (page 2, paragraph [0032]); and creating by the printer, in response to receipt of the document, a printable document in accordance with the pointer (Fig. 2, S200 and 220) (document is printed) (page 3, paragraphs [0037] and [0038]).

5. Regarding Claim 2, Parry discloses a method, further including retrieving the data pointed to by the pointer and including the retrieved data in the printable document (retrieved URL code is translated into print code) (page 3, paragraph [0037]).

6. Regarding Claim 3, Parry discloses a method, further including storing, by the printer in a database, the data pointed to by the pointer (plurality of different URL's which are maintained with up to date information) (page 3, paragraph [0045]).

7. Regarding Claim 4, Parry discloses a method, further including the pointer to the data as part of the printable document (barcode is printed as regular data) (page 2, paragraph [0032]).

8. Regarding Claim 5, Parry discloses a method, further including placing a bar code in the printable document that represents at least some of the data pointed to by the pointer (barcode is printed as regular data) (page 2, paragraph [0032]).

9. Regarding Claim 6, Parry discloses a method, further including placing a bar code in the printable document that represents a local storage location of at least some of the data pointed to by the pointer (barcode is printed as regular data) (page 2, paragraph [0032]).

10. Regarding Claim 7, Parry discloses a method, further including placing a bar code in the printable document that represents the pointer ((barcode is printed as regular data) (page 2, paragraph [0032]).

11. Regarding Claim 9, Parry discloses a method, wherein the pointer is a World Wide Web pointer (barcode includes URL) (page 2, paragraph [0033]).

12. Regarding Claim 10, Parry discloses a method, wherein the pointer is a URL (barcode includes URL) (page 2, paragraph [0033]).

13. Regarding Claim 12, Parry discloses a method, wherein the received document includes commands for the printer to perform a multimedia action (printer insert information) (page 2, paragraph [0033]).

14. Regarding Claim 13, Parry discloses a method, wherein the printer analyses the received document to extract the pointer from the document (Fig. 2, S100) (printer or

other device 10 detects one or more barcodes in the data on line 55) (page 2, paragraph [0032]).

15. Regarding Claim 17, Parry discloses a method, wherein the printer further interacts with a user before printing the document (Fig. 2, S180) (user makes selections) (pages 2 and 3, paragraph [0036]).

16. Regarding Claim 18, Parry discloses a method, further comprising: printing the printable document (Fig. 2, S220, print document); and receiving input in accordance with the document printed by the printer and retrieving multimedia data in accordance with the input (user given the opportunity to make a selection of the printing format and/or transmission of the document to another printer or other appropriate device) (pages 2-3, paragraph [0036]).

17. Regarding Claim 19, Parry discloses a method, comprising: receiving by a printer a document containing multimedia information (Fig. 2, S110) (data is applied on line to the input/output circuitry 50 of the device 10) (page 2, paragraph [0032]); and creating by the printer, in response to receipt of the document, a printable document in accordance with the multimedia information (Fig. 2, S200 and 220) (document is printed) (page 3, paragraphs [0037] and [0038]).

18. Regarding Claim 23, Parry discloses a method, wherein the multimedia information is a composite document (Fig. 2, S190 and S200) (page 3, paragraphs [0037 and [0038]).

19. Regarding Claim 24, Parry discloses a method, wherein the multimedia information points to multimedia content (barcode includes a URL) (page 2, paragraph

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[0032]) and further comprising retrieving the multimedia content in accordance with the multimedia information (printer retrieves the requested document) (page 2, paragraphs [0033] – [0036]).

20. Regarding Claim 25, Parry discloses a method, further comprising storing by the printer at least some of the multimedia information in a database (plurality of different URL's which are maintained with up to date information) (page 3, paragraph [0045]).

21. Regarding Claim 26, Parry discloses a method, further including printing at least a portion of the multimedia information as part of the printable document (Fig. 2, S210) (retrieved document is translated to printing code) (page 3, paragraph [0037]).

22. Regarding Claim 27, Parry discloses a method, further including placing a bar code in the printable document that represents at least some of the multimedia information (barcode is printed as regular data) (page 2, paragraph [0032]).

23. Regarding Claim 28, Parry discloses a method, further including placing a bar code in the printable document that represents a pointer to multimedia content (barcode is printed as regular data) (page 2, paragraph [0032]) and that further represents at least some of the multimedia content (one or more barcodes is detected) (page 2, paragraphs [0032]).

24. Regarding Claim 30, Parry discloses a method, wherein the multimedia information is a World Wide Web pointer to multimedia information (barcode includes URL) (page 2, paragraph [0033]).

25. Regarding Claim 32, Parry discloses a method performed by a printer, comprising: gathering information about multimedia data that is accessible to the printer

(maintain a variety of documents on the internet but accessible only by means of a PIN number) (page 3, paragraph [0045]); and creating a summary of the accessible multimedia data (only accessible by PIN number) (page 3, paragraph [0045]).

26. Regarding Claim 33, Parry discloses a method, further comprising printing the created summary (summary reports) (page 3, paragraph [0045]).

27. Regarding Claim 34, Parry discloses a method, where the printer is connected to a network (Fig. 1, internet 60) and can access multimedia data via the network (URL 70) (page 2, paragraph 0029).

28. Regarding Claim 35, Parry discloses a method, where the printer stores multimedia data and the stored data is the data accessible by the printer (plurality of different URL's which are maintained with up to date information) (page 3, paragraph [0045]).

29. Regarding Claim 36, Parry discloses a method, wherein the printer has access to a database containing multimedia data (plurality of different URL's which are maintained with up to date information) (page 3, paragraph [0045]).

30. Regarding Claim 40, Parry discloses a printer, comprising: means for receiving, by a printer, a document having a pointer pointing to data that is not in the received document (Fig. 2, S110) (data is applied on line to the input/output circuitry 50 of the device 10) (page 2, paragraph [0032]); and means for creating by the printer, in response to receipt of the document, a printable document containing at least a portion of the data pointed to by the pointer (Fig. 2, S200 and 220) (document is printed) (page 3, paragraphs [0037] and [0038]).

Claim Rejections - 35 USC § 103

31. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

32. Claims 8, 14-16, 29, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry in view of Dutta (US 2002/0135800).

33. Regarding Claim 8, Parry fails to teach a method, wherein the received document is a PDL file.

Dutta teaches a method, wherein the received document is a PDL file (page 4, paragraph [0044]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Dutta to allow the printer to be implemented in a variety of software environments.

34. Regarding Claim 14, Parry fails to teach a method, wherein the document is received from a print-driver that processes the document to identify the pointer.

Dutta teaches a method, wherein the document is received from a print-driver that processes the document to identify the pointer (Fig. 3, print driver 314) (page 5, paragraph [0053]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Dutta to

use a print driver to obtain the document information and forward that information to the printer.

35. Regarding Claim 15, Parry fails to teach a method, wherein the document is received from a plug-in that processes the document to identify the pointer.

Dutta teaches a method, wherein the document is received from a plug-in that processes the document to identify the pointer (Fig. 3, browser plug-in 306) (page 5, paragraph [0053]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Dutta to use a plug-in to render the document.

36. Regarding Claim 16, Parry fails to teach a method, wherein the document is received from a standalone application that processes the document to identify the pointer.

Dutta teaches a method, wherein the document is received from a standalone application that processes the document to identify the pointer (Fig. 3, browser application 32) (page 5, paragraph [0053]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Dutta to retrieve the document from a web server.

37. Claim 29 is rejected for the same reason as claim 8.

38. Regarding Claim 39, Parry fails to teach a method, where the summary includes a representation of graphical data.

Dutta teaches a method, where the summary includes a representation of graphical data (graphic files) (page 4, paragraph [0044]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Dutta to allow the printer to be implemented in a variety of software environments.

39. Claims 11, 20-22, 37, and 38 are rejected under 35 U.S.C. 103(a) as being unpatentable over Parry in view of Bozdagi et al. (US 2003/0041102).

40. Regarding Claim 11, Parry fails to teach a method, wherein the printable document includes at least one frame grab of video data pointed to by the pointer.

Bozdagi et al teach a method, wherein the printable document includes at least one frame grab of video data pointed to by the pointer (Fig. 8, frame select 560) (page 2, paragraph [0028]).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include a selected frame of video in the printed document.

41. Regarding Claim 20, Parry fails to teach a method, wherein the multimedia information is video.

Bozdagi et al teach a method, wherein the multimedia information is video (sequence of video frames) (col. 3, lines 30-44).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include a selected frame of video in the printed document.

42. Regarding Claim 21, Parry fails to teach a method, wherein the multimedia information is audio

Bozdagi et al teach a method, wherein the multimedia information is audio (digital audio data) (col. 3, lines 30-44).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include audio data in the printed document.

43. Regarding Claim 22, Parry fails to teach a method, wherein the multimedia information is animation.

Bozdagi et al teach a method, wherein the multimedia information is animation (Fig. 9, animation) (animated GIF) (col. 11, lines 50-65).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include animation in the printed document.

44. Regarding Claim 37, Parry fails to teach a method, where the summary includes a representation of audio data.

Bozdagi et al teach a method, where the summary includes a representation of audio data (digital audio data) (col. 3, lines 30-44).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include audio data in the printed document.

45. Regarding Claim 38, Parry fails to teach a method, where the summary includes a representation of video data.

Bozdagi et al teach a method, where the summary includes a representation of video data (sequence of video frames) (col. 3, lines 30-44).

Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to have combined the teachings of Parry with the teaching of Bozdagi to include a selected frame of video in the printed document.

Conclusion

46. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Bloomberg (US 6,439,465) discloses encoding small amount of embedded digital data at arbitrary location within an image.

Sun et al. (US 6,678,389) discloses a method and apparatus for embedding digital information in digital multimedia data.

Lapstun et al. (US 6,824,044) disclose a method of enabling a user to obtain, via coded data disposed on a surface, a document related to content of a video signal.

Lofgren et al. (US 2004/0044894) disclose transforming data files into logical storage units for auxiliary data through reversible watermarks.

Kanai et al. (US 2004/0125402) disclose a document protecting system based on security policy.

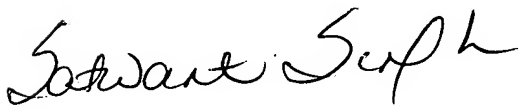
Sinisi (US 2004/0128613) discloses a system and method for mobile data collection in which a handheld device collects and integrates one or more forms of data.

Contact Information

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Satwant K. Singh whose telephone number is (571) 272-7468. The examiner can normally be reached on Monday thru Friday 8am - 4:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kimberly A. Williams can be reached on (571) 272-7471. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



sks

Satwant K. Singh
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